

REMARKS

Applicants acknowledge receipt of an Office Action dated May 7, 2009. No claims are presently cancelled or amended. Therefore, claims 1-40 are pending, whilst only claims 1-18 are examined on the merits. Applicants respectfully request reconsideration of the present application in view of the reasons below.

In the Office Action, the PTO refused to examine that which the Office itself, in the previous Office Action, characterized as constituting a single invention. That is, in the Office Action mailed on March 12, 2009 the PTO divided the original claims into four groups, each comprising a single invention. Following Applicants' election with traverse of Group I (Claims 1-18) and their election of the species shown in Example 1-31, the PTO now has objected to Claims 1-18 "for containing non-elected subject matter" and has required that the Group I claims be "amended to exclude non-elected subject matter and within the scope of elected compound." In doing so, the PTO has attempted to rewrite generic claim 1 by arbitrarily constricting Y to cycloalkyl, Ar¹ to aryl, and Ar² to heteroaryl. Applicants respectfully traverse the objection because it is contrary to law and because a claim so restricted *would not read on Applicants' elected species*.

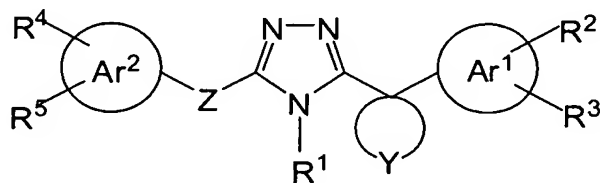
The PTO lacks authority, as here, to impose a restriction upon an individual claim. Thirty years ago in *in re Weber*, the Court of Customs and Patent Appeals held that the PTO's need to limit an examination to one invention per filing fee is trumped by an applicant's statutory right to claim his invention as he chooses. *In re Weber*, 580 F.2d 455, 458-49, 198 U.S.P.Q. 328, 331-32 (C.C.P.A. 1978).

Further, the PTO's present requirement constitutes restriction of subject matter of an individual claim that is prohibited under both PCT Rule 13.2 and MPEP 803.02. As applied to Markush practice, PCT Rule 13.2 states that a Markush group fulfills requirements for Unity of Invention when the group members share one or more of the same "special technical features." For a Markush grouping of chemical compounds, Annex B, part 1(f), explains that the requirements for Unity of Invention are satisfied when i) all alternatives have a common property or activity; and ii) a significant structural element is shared by all alternatives. Claim 1 clearly fulfills both of the requirements for unity of invention.

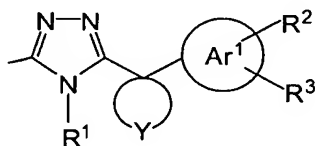
Common property or activity. The common property shared by compounds of this invention is their activity as HSD1 inhibitors. This activity is the stated utility of the compounds and is clearly

evident from the specification. For example, at ¶ 0028, the specification characterizes this invention as providing novel compounds with superior HSD1 inhibiting activity which are useful in treating diabetes and obesity.

Significant structural element shared by all alternatives. The substantial structural feature that is essential to the asserted utility and that is shared by all members of the genus is immediately obvious in the generic structural formula of Claim 1, which is shown below:



These compounds are all 3,5-di-substituted triazoles, where the aromatic substituents are linked to the central triazole by a methylene bridge which is optional in the case of Ar². Moreover, at the 5-position, the methylene bridge to Ar¹ is part of a saturated ring Y. Indeed, the 5-(1-aryl- or (1-heteroaryl-cycloalkyl) – (4*H*) – [1,2,4-triazol-3-yl] group shown below must suffice as the common structural element that defines this genus: it represents three quarters of the atoms in the structure.



Moreover, in the pharmaceutical arts, to which this invention pertains, substitution of a pyridyl or thienyl group for a phenyl group in such a moiety must be retained as an option in order to preserve the essential features of the invention.

On page 3 of the Office Action, the PTO stated that

“the ring structure of formula [I] is further substituted by different variables, which are broadly defined and when the compound of formula [I] is taken as a whole, a *plethora of vastly different* compounds are possible. *Thus*, these features are not considered ‘special technical features’ under PCT rules 13.1 and 13.2. Hence, unity of invention is considered to be lacking...” (emphasis added)

The PTO’s bald connection between an excess of compounds and a paucity of special technical features, essentially turning upon its own *ipse dixit* (“Thus...”), is logically equivalent to saying

"Apples; thus, oranges." At best, the PTO's statement is clearly circular, that is, assuming that which it purports to prove. The PTO has posited no explanation or support for its conclusion other than a criticism lacking legal significance.

Contrary to the Office's assertion of "vast differences" among compounds, the explanation above demonstrates an abundance of common features shared by all members of the recited Markush group. As to the asserted excess of compounds, the PTO appears to believe that because this genus embraces many compounds, and may require different fields of search, claim 1 *ipso facto* lacks unity of invention and may therefore be carved up into separate inventions. That is not the law: it is well settled that even different fields of search within a Markush grouping do not negate unity of invention or render the Markush grouping otherwise improper. *Ex parte* Brouard, Leroy, and Stiot, 201 USPQ 538, 540 (BPAI 1976).

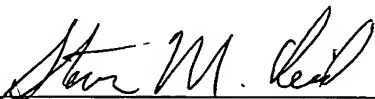
CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

If Examiner Shameem believes that any outstanding issue warrants discussion, he is courteously invited to contact Applicants' undersigned attorney by telephone at the number below.

Respectfully submitted,

Date July 14, 2009

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.